

REMARKS

The Office Action dated August 19, 2010, and the Advisory Action dated November 30, 2010, have been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto. Claim 6 has been rejected. Claims 1, 2, and 5 have been cancelled. Claims 3 and 4 stand withdrawn. Thus, claim 6 is pending in this application. The Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. §102

Claim 6 is rejected under 35 U.S.C. §102(b) as being anticipated by Sumitomo Electric Industries, Ltd. (JP 8-165582 A). To the extent the rejection remains applicable to Claim 6, as currently amended, the Applicants respectfully traverse the rejection for at least the following reasons.

Claim 6 recites a component of a film forming equipment for forming a thin film on a substrate, the component having a matrix material, a first means, on the matrix material, for forming a first local cell, when exposed to a cleaning liquid, with the matrix material, the first means being of such a character that a first local current flows from the matrix material to advance dissolution of the first means at an interface between the first means and the matrix material and to allow the removal of a film layer of the thin film from the matrix material, and a second means, on the first means, for forming a second local cell, when exposed to a cleaning liquid, the second means being of such a character that a second local current flows from the second means to advance

dissolution of the first means at an interface between the first means and the second means and to allow the removal of the film layer of the thin film from the matrix material.

Sumitomo simply teaches a terminal material provided by forming a chromium layer 2 between a gold plated layer 3 and a copper base material 1 (Abstract). The Patent Office appears to assert that the claimed features of the first and second means are inherent in the material of Sumitomo. However, Sumitomo fails to teach a component of a film forming equipment for forming a thin film, as recited in independent claim 6. The Examiner continues to assert that the above-underlined features have no patentable weight because they are recited in the preamble. The Applicants respectfully disagree.

As pointed out in the Response filed on November 19, 2010, MPEP §2111.02 states that “[t]he determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim.” This clear statement eliminates the possibility by the Patent Office of refusing to consider the preamble outright and without further consideration. MPEP §2111.02 further states that “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claims, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

In this case, it is only by the preamble that it can be known that the subject matter defined by the claim is comprised as a component of a film forming equipment for forming a thin film on a substrate. The Applicants respectfully note that aspects of

the first means and the second means are specifically directed to defining the removal of a film layer of the thin film from the matrix material. In fact, the entire essence and vitality of Claim 6 lies in the removal of the film layer of the thin film, wherein as claimed, the first means, when exposed to a cleaning liquid, is of such a character that a first local current flows from the matrix material to advance dissolution of the first means at an interface between the first means and the matrix material and to allow the removal of the film layer of the thin film from the matrix material, and the second means is of such a character that a second local current flows from the second means to advance dissolution of the first means at an interface between the first means and the second means and to allow removal of the film layer of the thin film from the matrix material. As such, not only does the preamble clearly serve to further define the structure of the claimed article, the body of the claim absolutely depends on the introductory phrase for completeness (see, e.g., *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 88 U.S.P.Q. 478 (1951)). The preamble of Claim 6 is necessary to give life, meaning, and vitality to the claims.

Moreover, the Applicants respectfully submit that Sumitomo does not disclose, and actually teaches away from, the first means being of such a character that a first local current flows from the matrix material to advance dissolution of the first means at an interface between the first means and the matrix material and to allow the removal of a film layer of the thin film from the matrix material, and a second means, on the first means, for forming a second local cell, when exposed to a cleaning liquid, the second means being of such a character that a second local current flows from the second means to advance dissolution of the first means at an interface between the first means

and the second means and to allow the removal of the film layer of the thin film from the matrix material. The entire of object of Sumitomo is to maintain the chromium layer 2 between the gold plated layer 3 and the copper base material 1 in order to prevent a contact resistance from developing between the gold plated layer 3 and the copper material 1. Accordingly, because the asserted structure of Sumitomo is not a component of a film forming apparatus for forming a thin film on a substrate, Sumitomo does not disclose or suggest, and teaches away from, a structure to advance the dissolution of the chromium layer when exposed to a cleaning liquid, as recited in Claim 6.

Furthermore, MPEP §2111.02 (II) states that “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention” (emphasis added). In the responses filed on March 4, 2009, and November 19, 2010, as well as the present response, the Applicants place clear reliance on the preamble to give life and vitality to the meaning of the claim. According to MPEP §2111.02 (II), such clear reliance on the preamble transforms the preamble into a claim limitation. Thus, the Applicants submit that Sumitomo fails to disclose or suggest the feature of a component of a film forming equipment for forming a thin film, as recited in independent claim 6. Moreover, the Applicants respectfully submit that claim 6 also does not disclose, and actually teaches away from, the first means being of such a character that a first local current flows from the matrix material to advance dissolution of the first means at an interface between the first means and the matrix material and to allow the removal of a film layer of the thin

film from the matrix material, and a second means, on the first means, for forming a second local cell, when exposed to a cleaning liquid, the second means being of such a character that a second local current flows from the second means to advance dissolution of the first means at an interface between the first means and the second means and to allow the removal of the film layer of the thin film from the matrix material.

For at least the combination reasons provided above, the Applicants respectfully submit that claim 6 is patentable over Sumitomo and request withdrawal of the rejection of claim 6 under 35 U.S.C. §102(b).

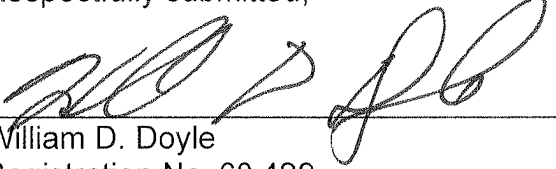
Conclusion

For at least a combination of the reasons provided above, it is respectfully submitted that the Claim 6 is in condition for allowance and a Notice of Allowability is earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is invited to contact the undersigned representative at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 referencing client matter number 026390-00028.

Respectfully submitted,



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